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EXAMINER	
HAMILTON, LALITA M	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/745,818
Filing Date: December 21, 2000
Appellant(s): HANSMANN ET AL.

Kevin P. Radigan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 25, 2005.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,637,846	Boers	6-1997
WO 99/66456	Brookner	December 23, 1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boers in view of Brookner (WO 99/66456).

Boers discloses a method and a corresponding system and program product for electronic payment by a client in a self-service store comprising a contactless label chipcard attached to a product containing at least information for identifying said product and said payment status and a component for execution of the update of the payment status of said product (col.4, lines 1-14), a device for reading and initiating update of the payment status comprising at least: a contactless reader for reading information stored in said contacless label chipcard (col.4, lines 1-30), a component for generating invoice based on said information received from said contactless label chipcard (col.4, lines 1-30 and col.5, lines 15-25), a component for checking payment of said invoice (col.5, lines 15-65), and a component for initiating update of the payment status (col.5, lines

15-65); the label chipcard contains following information: Label ID, Product ID, Payment status PAID or NOT PAID, and AuthenticationKey (col.4, lines 1-30 and col.5, lines 15-25); label chipcard additionally contains product price information (col.4, lines 4-30); information are stored in the non-volatile memory of said label chipcard (col.4, lines 1-30); contactless reader comprising at least a component for sending to and receiving information from said label chipcard (col.4, lines 1-30); contactless reader uses inductive coupling for data transmission (col.4, lines 1-30); contactless label chipcard comprises at least a component for sending to and receiving information from said contactless reader (col.4, lines 1-30); contactless reader comprises at least a component for sending to and receiving information from said label chipcard, said contactless reader further comprising a generator for generating a RF-field whereby said contactless reader and said contactless label chipcard uses said RF-field for data transmission (col.4, lines 1-30); component for generating an invoice has access to enterprise data not contained in said label chipcard for generating an invoice (col.5, lines 15-65); device for reading and initiating the update of the payment status further comprises a data processing device with non-volatile memory for storing said component for checking the payment of said invoice and said component for initiating the update of the payment status in said contactless label chipcard, a data connection between said data processing device and said reader, a display device for displaying invoice information, and a warning device for detecting not paid products (col.4, lines 1-30 and col.5, lines 5-65); a contact card reader as payment means and a contactless card reader as payment means (col.4, lines 1-30); device for reading and initiating the

update of the payment status is part of a check-out system (col.5, lines 5-65); a component for sending to and receiving information from a contactless reader, a non-volatile memory containing at least following information: Label ID, Product ID, Payment status PAID or NOT PAID, and

AuthenticationKey, and a component for execution of the update of the payment status by means of authentication (col.4, lines 1-30 and col.5, lines 1-65); a contactless reader for reading information stored in said contactless label chipcard, a component for generating an invoice based on said information received from said contactless label chipcard, a component for initiating update of the payment status on said label chipcard, a data processing device for storing said a component for checking the payment of said invoice and said component for initiating update of the payment status in said contactless label chipcard, a data connection between said data processing device and said reader, a display device for displaying invoice information, and a warning device for detecting not paid products (col.4, lines 1-30 and col.5, lines 1-65); a method for executing payments in a system comprising the steps of detecting presence of a contactless label chipcard in the range of the contactless reader, requesting product information from said detected label chipcard, storing product information in a memory of said device, repeating aforementioned steps for all label chipcards detected in the range of said contactless reader, generating invoice based on said information stored in said memory, execution of payment and examination of validity of said payment, sending "RequestSetPaid" with authentication protocol information by said component for initiating update of the payment status via said contactless reader to a selected label

chipcard if the payment was valid, execution of said "RequestSetPaid" on said selected label chipcard by said component for execution the update of the payment status when the authentication protocol information provided with said "RequestSetPaid", repeating execution step for all articles or products covered by the invoice, and inactivating said warning system (col.4, lines 1-30 and col.5, lines 1-65); product information contains a product identification ID and/or a product price information (col.4, lines 1-30); product price information can be changed by an authorized device (col.4, lines 1-30); invoice is generated with further product data identified by means of said information provided by said label chipcard (col.5, lines 15-65); the execution of payment is supported by an user interface with different option of payment (col.5, lines 15-65); the step of detecting presence of the label chipcard comprises the further steps detecting presence of a contactless payment chipcard in the range of the contactlesss reader and offering use of the detected contactless payment chipcard for performing the payment (col.4, lines 1-30 and col.5, lines 1-65); authentication protocol information is a digital signature or a MAC execution of said "RequestSetPaid" on said selected label chipcard by said component for execution; a computer program product stored in the internal memory of a computer containing parts of software code for performance of the method of the above claim if the product is implemented on the computer; (col.4, lines 1-30 and col.5, lines 1-65); a computer program product stored in the internal memory of a computer containing parts of software code for performance of the above claim if the product is implemented on the computer (col.4, lines 1-30 and col.5, lines 1-65); and computer program product stored in the internal memory of a computer containing parts of

software code for performance of the method of the above claim if the product is implemented on the computer (col.4, lines 1-30 and col.5, lines 1-65); however, Boers does not disclose a component for initiating update of the payment status in the contactless label chipcard. Boer teaches barcodes on products in the store that may be scanned. Brookner teaches a method and corresponding system for generating indicia indicative of payment comprising a component for initiating update of the payment status in the contactless label (see abstract and p.2, line 19 to p.3, line 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a component for initiating update of the payment status in the contactless label, as taught by Brookner into the invention disclosed by Boers, to ensure that products that have been purchased have been paid for prior to exiting the store.

(11) Response to Argument

The Appellant argues that the final Office Action misinterpreted the teachings of the Boers and Brookner patents and that there is no basis for combination. In response, the Appellant amended independent claim 1 to "initiate update of the payment in the contactless label chipcard". By doing so, the Examiner was forced to change the rejection and incorporate Brookner as a teaching of updating the payment status in the contactless label chipcard. Brookner teaches generating means indicative of payment in a contactless label. Therefore, the Examiner found basis for combination.

The Appellant argues that Boers does not teach or suggest a contactless label chipcard attached to a product and containing information identifying the product payment status thereof, a component to facilitate execution of an update to the payment

status, or a device for reading and updating the payment status on the contactless label. In response, Boers discloses a scanner for reading binary codes stored in a chip that is attached to articles in the store (col.4, lines 1-30), which the Examiner interpreted as being a contactless label chipcard. The scanner may be used to read and update the status of the contactless label chipcard (col.4, lines 1-30 and col.5, lines 1-65). Brookner teaches updating the payment status of a contactles label; therefore, the Examiner found it to have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Brookner as a teaching of the payment status being updated in the contactless label chipcard disclosed by Boers, since Boers does disclose that a payment status may be updated in a contactless chip card for use in identification and payment (col.5, lines 40-65). The payment status may be updated by a scanner or equivalent means when the customer checks out.

The Appellant argues that the scanner disclosed by Boers is not attached to the product itself. In response, the Examiner was unable to find any mention of a scanner being attached to the product itself in the claims.

With regard to Brookner, the Appellant argues that there is no teaching of a contactless label chipcard or a contactless label attached to a product. In response, Brookner was not incorporated as a teaching of a contactless lable chipcard. The Examiner never mentioned Brookner as teaching a chipcard, but rather a contactless label. The printed indicum may be used to update the payment status by scanning means, which the Examiner interpreted as being a contactless label.

The Appellant argues that the label chipcard contains payment status "paid" or

"not paid", and Boers does not disclose this limitation. In response, Boers discloses that a contactless label chipcard may be used to reflect the payment status of "paid" or "not paid" (col.5, lines 40-65).

The Appellant argues that Boers does not disclose or suggest any system where a contactless label chipcard is attached to a product, which contains specific updated payment status information. In response, Boers discloses that a contactless label chipcard may be used to reflect the status of a payment (col.5, lines 40-65).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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June 9, 2005

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